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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/355,422 07/28/99 KLOWER

J EXAMINER 162-025

IM22/0420

ART UNIT	PAPER NUMBER
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OLTMANS, A

6

DATE MAILED:

1742

04/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/355,422	KLOWER ET AL.
	Examiner Andrew L Oltmans	Art Unit 1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1) Responsive to communication(s) filed on _____.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:

1. received.

2. received in Application No. (Series Code / Serial Number) _____.

3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) Notice of References Cited (PTO-892) 17) Interview Summary (PTO-413) Paper No(s). _____.

15) Notice of Draftsperson's Patent Drawing Review (PTO-948) 18) Notice of Informal Patent Application (PTO-152)

16) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.5. 19) Other: _____

Art Unit: 1742

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In claim 2, the ranges of C and Mg falls outside the range of composition recited in the parent claim. The dependent claim cannot broaden the scope of the independent claim.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 5-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 5-7 are drawn to a use (i.e. utilization) of the alloy, which is not a statutory category of invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1742

5. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 6, line 2, the term, "composite pipes", renders the claim indefinite because it is unclear of the precise meaning of the term.
- b. In claim 7, line 2, the phrase, "corrosion protection in form of applied welding or plating", renders the claim indefinite because it is unclear what the applicant is attempting to claim. For example, it is unclear how a weld can provide corrosion resistance.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Kondo et al. 4,110,110

7. Claims 1, 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. 4,110,110 (Kondo).

Kondo teaches a nickel-based alloy composition having 10-25% Cr, at least one of 0.1-10% Mo, 0.1-30% Fe, 0.1-25% W, and 0.05-30% Co, 0.05-0.5 Si, 0.04-0.25% C, 0.001-0.2% Al,

Art Unit: 1742

0.001-0.05% Ti, and B, Zr, Mg, Ca, rare earths, in overlapping concentrations (col 1, lines 18-44). Kondo teaches a non-preferred embodiment where the silicon concentration exceeds 0.5% (col 4, line 63 to col 5, line 10; col 7-10, Table 4).

Kondo fails to meet all the limitations of the instant claims in that Kondo does not explicitly teach the exact same compositional ranges, austenitic structure, preferred embodiments containing Si in amounts greater than 0.5%, or the uses recited in claim 5-7.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy taught by the reference has a composition which overlaps that of the instant claims, *In re Malagari*, 182 USPQ 549, and MPEP 2144.05.

With respect to the austenitic structure, although the reference remains silent to the structure of the alloy, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy composition taught by the references overlap the alloy composition recited in the claims and therefore one of ordinary skill in the art would expect that the products taught by the references would be the same as applicant's claimed product, including the properties of structure.

"Where the claimed and prior art products are identical or substantially identical in structure or composition or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best* 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best* 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

Art Unit: 1742

With respect to the Si, the reference is not limited to the preferred embodiments, but rather is read as a whole, MPEP 2123:

“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

If the reference is read as a whole, the addition of greater than 0.5% Si is taught, therefore making the instant invention obvious.

With respect to the uses, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

German Patent 1,233,609

8. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent 1,233,609 cited in IDS filed September 13, 1999 ('609).

Art Unit: 1742

'609 teaches 5-30% Cr, 0-15% Mo, 0-1.5% Si, 0.01-0.3% C, 0-5% Fe, 0-1% Mn, 0.1-9% Al, 0.1-6.5% Ti, less than 0.15% Mg, 0-6% V, less than 0.02% P, less than 0.01% S, 0-0.3% B, 0-0.9% Cu, 0-30% Co, 0-7% Nb, 0-8% Hf, 0-1.2 Zr, balance Ni and impurities, which overlaps that recited in the instant claims (claim 1).

'609 fails to meet all the limitations of the instant claims in that '609 does not explicitly teach the exact compositional ranges recited in the claims, the austenitic structure, or the Ca.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy taught by the reference has a composition which overlaps that of the instant claims, *In re Malagari*, 182 USPQ 549, and MPEP 2144.05.

With respect to the austenitic structure, although the reference remains silent to the structure of the alloy, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy composition taught by the references overlap the alloy composition recited in the claims and therefore one of ordinary skill in the art would expect that the products taught by the references would be the same as applicant's claimed product, including the properties of structure, MPEP 2112.01.

With respect to the Ca, although the reference is silent to Ca, one of ordinary skill in the art would recognize that Ca is a known impurity for nickel-chromium alloys. In view of the fact that Ca is a known impurity, one of ordinary skill in the art would recognize that the impurities in the alloy taught by the reference would include Ca.

Art Unit: 1742

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Baldwin teaches a nickel alloy composition that is similar to that of the instant claims, but has a silicon composition lower than that recited in the instant claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Oltmans whose telephone number is 703-308-2594. The examiner can normally be reached on 8:30-5:00.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Alo
ALO
April 14, 2000

John Sheehan
JOHN SHEEHAN
PRIMARY EXAMINER
GROUP 1300
1742